



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/528,376

12/05/2005

Masamichi Morita

Q86778

6763

23373 7590 02/19/2009
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

HIGGINS, GERARD T

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

02/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 02/02/2009 will be entered as it simplifies issues for purposes of appeal; however, it is noted that the objection to claim 1 remains because on lines 23 and 34 of claim 1 the phrase "having 1 to 22 carbon atoms" is still in parenthesis. This phrase is not optional and therefore the parenthesis should be removed.

The rejection of claims 1-6 under 35 U.S.C. 112, second paragraph has been removed because applicants have corrected the indefiniteness of claim 1.

The claims stand rejected for reasons of record and the reasons set forth below.

The declaration under 37 CFR 1.132 filed 02/02/2009 is insufficient to overcome any of the rejections of claims 1-6 under 35 U.S.C. 103(a) based upon the references Ishida (JP 2002-023356), Ishida et al. (JP 2001-284289), Furusawa et al. (JP 2001-284274), and Katz (EP 1041652) as set forth in the last Office action because: the facts presented are not germane to the rejection at issue and applicants have not compared the closest related compounds from the prior art.

The Examiner cited the fluoroalkylsilane trifluoropropyl trimethoxysilane in each of his rejections. It is noted that applicants' Remarks mention this compound as being disclosed by the references Ishida '356, Ishida 289, and Furusawa '274 (see page 10 of applicants' Remarks). The Examiner proposed to modify or substitute the trifluoropropyl group on this trifluoropropyl trimethoxysilane. The Examiner did not start with

Art Unit: 1794

heptadecafluorotetrahydrodecyl triethoxysilane, heptadecafluorotetrahydrodecyl trichlorosilane, or tridecafluorotetrahydrooctyl trichlorosilane, and therefore it is unclear why applicants are comparing these compounds (Comparisons B and C) to their inventive compounds (a)-(f). Each of trifluoropropyl trimethoxysilane, perfluoropropyl trimethoxysilane, and perfluoroisopropyl trimethoxysilane are the closest related compounds from the prior art rejections. Applicants have not shown a comparison with trifluoropropyl trimethoxysilane; furthermore, applicants have not shown a comparison with perfluoropropyl trimethoxysilane, which was rendered obvious by the Examiner in sections 7 and 9 of the Office action mailed on 10/03/2008, and finally applicants have not shown a comparison with perfluoroisopropyl trimethoxysilane, which was rendered obvious in sections 8 and 10 of the Office action mailed on 10/03/2008.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-F 9:30am-7pm est. (1st Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gerard T Higgins
Examiner
Art Unit 1794

/Gerard T Higgins/
Examiner, Art Unit 1794

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794